



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/873, 974 06/12/97 SCROGGIE

M CATALINA

022850

TM02/0619

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

EXAMINER

ROBINSON ROYCE A

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|---|---|
| Office Action Summary | Application No. 08/873,974 | Applicant(s) Scroggie, et al. |
| | Examiner Akiba Robinson-Boyce | Art Unit 2163 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Apr 11, 2001

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 50-89 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 50-89 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

Art Unit: 2163

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 50, 51, 60, 70, 80, are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claims 50, 60, 70, 80, Sloane discloses:

a cooperative network site configured to store at least one of manufacturer incentives.../storing at least one of .../means for storing...at least one manufacturer network site and a retailer network site coupled.../coupling at least one network site.../means for coupling at least one of a manufacturer...a consumer computer coupled.../coupling a consumer computer.../means for coupling a consumer computer...wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives.../transmitting from said cooperative network.../means for transmitting...(Col. 7, lines 4-26).

As per claims 51, 61, 71, 81, Sloane discloses:

Art Unit: 2163

wherein said cooperative network site is configured to store at least one of said manufacturer incentives and retailer incentives in a data base.../storing at said cooperative network site.../means for storing...(Col. 8, lines 50-54).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 52-59, 62-69, 72-79, 82-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211) as applied to claim above, and further in view of Narasimhan, et al (US Patent 6,237,145 B1).

As per claims 52, 54-56, 58, 59, 62, 64-66, 68, 69, 72, 74-76, 77, 78, 79, 82, 84-86, 87, 88, 89, Sloane fails to disclose the following, however Narasimhan, et al discloses:

wherein, in response to said consumer transmitting an identification code.../transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code.../means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site in response to said consumer transmitting an identification code...wherein said incentive data is

Art Unit: 2163

based on said consumer specific data.../basing said incentive data on said consumer specific data.../means for basing...(Col. 6, lines 50-59, Col. 4, lines 41-45, Col. 9, lines 5-12); wherein, in response to a query from said consumer made over said communication .../transmitting from said cooperative network site a geographically limited.../means for transmitting from said cooperative network site a geographically limited...(Col. 3, lines 27-29 read w/ Col. 8, lines 4-7).

 said cooperative network site transmits a consumer personal page.../transmitting from said cooperative network site a consumer personal page.../means for transmitting from said cooperative network site a consumer personal page...(Col. 4, lines 41-45);

 said consumer transmits incentive selection data.../transmitting by said consumer.../means for transmitting by said consumer incentive selection data...said cooperative network site transmits incentives corresponding to said selection data.../transmitting from said cooperative network...../means for transmitting from said cooperative network site...(Col.6, lines 13-16).

It would have been obvious to one of ordinary skill in the art to transmit a geographically limited list of retailers honoring incentives in response to a query because by querying, all of the unwanted data can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Narasimhan, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

Art Unit: 2163

As per claims 53, 63, 73, 83, Sloane fails to disclose the following, however Narasimhan, et al discloses:

wherein said cooperative network site transmits said geographically limited list of retailers.../transmitting from said cooperative network site said geographically limited list of retailers...(Col. 4, lines 62-65, Col. 8, lines 4-7).

It would have been obvious to one of ordinary skill in the art for cooperative network site to transmit the geographically limited list of retailers in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer.

Neither Sloane or Narasimhan, et al disclose the following:

based on a postal code...

Official notice is taken that it is old and well known in the art to have a geographical list sorted by postal code. It would have been obvious to one of ordinary skill in the art to sort a geographical list by postal code in order to specifically define the closest locations.

As per claims 57, 67, Sloane discloses:

wherein said incentive data is based on said consumer specific data comprising a shopping history...(Col. 8, lines 50-63).

Conclusion

Art Unit: 2163

5. An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30 AM-3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Akiba Robinson-Boyce

Patent Examiner

Group Art Unit 2163

June 12, 2001


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100